

REMARKS

In the Office Action that was mailed on November 4, 2003, Figure 1 was objected to; claims 1-14 were objected to due to informalities; claims 1-14 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness; and claims 1-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hotta et al. (U.S. Patent No. 6,345,119) ("Hotta") in view of Shirasaki et al. (U.S. Patent No. 6,341,176) ("Shirasaki"). The foregoing objections and rejections are respectfully traversed.

Claims 1-16 are pending in the subject application, of which claims 1, 2, 15, and 16 are independent claims.

Recordation of Assignment:

On September 13, 2000, an Assignment and Form PTO-1595 were filed. On March 12, 2004, the Applicants filed a Second Request For Notice Of Recordation Of Assignment Document. To this date, the Applicants have not yet received a Notice Of Recordation Of Assignment Document. The Applicants respectfully request that the same be mailed to the undersigned as soon as possible.

Amendments to the Specification:

Page 10, line 15 through page 14, line 16 of the Specification is amended herein to change the term "device" to "program" in regard to input device 10, first recognition device 12, second recognition device 15, extraction device 18, and output device 20. Care has been exercised to avoid the introduction of new matter.

Amendments to the Claims:

Claims 1-14 are amended herein to change the term "device" to "program" in several instances. Care has been exercised to avoid the introduction of new matter.

Amendments to the Figures:

Figure 1 is amended herein to change the term "device" to "program" in regard to input

device 10, first recognition device 12, second recognition device 15, extraction device 18, and output device 20. Care has been exercised to avoid the introduction of new matter.

Objections to the Claims:

Claims 1-14 have been amended herein, taking the examiner's comments into consideration, and directed to overcoming the objections. The Applicants respectfully request that the examiner withdraw the objections thereto.

Objections to the Figures:

Figure 1 has been amended herein, taking the examiner's comments into consideration and directed to overcoming the objections. The Applicants respectfully request that the examiner withdraw the objections thereto.

Rejections of the Claims:

Rejections Under 35 U.S.C. § 112:

Claims 1-14 have been amended herein to recite the term "program" instead of "device" in several instances. The Applicants assert that such claims are sufficiently definite, and respectfully request that the examiner withdraw the rejections thereto under § 112, second paragraph.

Rejections Under 35 U.S.C. § 103(a):

Differences Between the Claimed Invention and the Cited References:

Independent claim 1 (as amended herein) recites "a multiple recognition program to separately perform character recognition of the text image using respective recognition methods." Independent claim 2 (as amended herein) recites "a first recognition program to recognize the characters in the text image using a first character recognition method [and] a second recognition program to recognize the characters in the text image using a second character recognition method different from the first character recognition method." Independent claims 15 and 16 recite "recognizing characters in the text image using a prescribed recognition

method [and] recognizing characters in the text image using a recognition method different from the prescribed recognition method."

The examiner cited Figures 1 and 4 of Hotta as discussing the multiple/first/second recognition program and the recognition methods. (Office Action, p. 4-6). The examiner did not suggest that Shirasaki discloses or suggests the same.

The Applicants respectfully assert that neither Hotta nor Shirasaki discloses or suggests the quoted features above. Therefore, independent claims 1, 2, 15, and 16 are patentably distinguishable over the cited references. Dependent claims 3-14 are allowable based in part on their dependency, directly or indirectly, from one of independent claims 1, 2, 15, and 16.

Lack of Motivation to Combine Hotta and Shirasaki:

In addition, the Applicants respectfully assert that the examiner has not made a *prima facie* case of obviousness under § 103. Specifically, MPEP § 706.02(j) requires that, to establish a *prima facie* case of obviousness under § 103, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. ... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure."

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The examiner has not presented any evidence why Hotta and Shirasaki would have been combined. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. Id. The examiner's sole support for such a combination is that it would enable "further output and display [sic] the misrecognized character so that the operator can further selected [sic] the appropriate character." (Office Action, p. 4) (errors in original). The examiner further asserted that "[t]his would improve processing" (Office Action, p. 4). The examiner cannot rely on the benefit of the combination without first supporting the motivation to make the combination, and the examiner has not presented any actual evidence in support of the same. Instead, the examiner relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and must be withdrawn.

Withdrawal of the foregoing objections and rejections is respectfully requested.

There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested. Finally, if there are any formal matters remaining after this response, the examiner is requested to telephone the undersigned to attend to these matters. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: _____

3-24-2004

By: _____



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